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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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PERKINS COIE LLP P.O. BOX 2168 MENLO PARK, CA 94026			EXAMINER FLEURANTIN, JEAN B	
			ART UNIT 2162	PAPER NUMBER
			MAIL DATE 01/25/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/720,031

Applicant(s)

SPIVACK ET AL.

Examiner

JEAN B. FLEURANTIN

Art Unit

2162

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-4, 11-15, 17, 19 and 22-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-4, 11-15, 17, 19 and 22-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 43-47 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. This is in response to Applicant(s) arguments filed on 11/09/2007.

The following is the current status of claims:

Claims 1, 5-10, 16, 18, 20, 21 have been canceled.

Claims 29-47 have added.

Claims 2-4, 11-15, 17, 19, 22-47 remain pending for examination.

Applicant's arguments filed 11/09/2007, with respect to claims 2-4, 11-15, 17, 19, 22-47 have been fully considered but they are not persuasive for the following reasons, see sections I (response to arguments) and II (repeated rejections).

Response to Arguments

I. Applicant's arguments start from page 11 through page 15.

Applicant's arguments with respect to claims 2-4, 11-15, 17, 19, 22-47 have been fully considered but they are not persuasive in part. Because, the prior art of record discloses the claimed limitations.

Newly submitted claims 43-47 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Claim(s) recite(s):

A method, comprising:

receiving a user request to create a semantic object of a first type to represent an offering;

providing the user with a template associated with the semantic object of the first type; wherein one or more entries of the template are submitted by the user to indicate a first set of criteria for identifying a first suitable set of recipients;

creating the semantic object of the semantic object type to represent the offering, the semantic object having a plurality of meta-tags associated with the one or more entries of the template;

wherein the plurality of meta-tags comprises a predetermined set of meta-tags based on the semantic object type;

optionally linking the semantic object to one or more of other semantic objects; wherein the linking is one or more of user-specifiable based on a second set of criteria and machine-specifiable based on semantic matching;

identify the suitable set of recipients based on the first set of criteria;

identifying a second suitable set of recipients based on semantic matching; and

sending the offering represented by the semantic object to the first and second suitable set of recipients over a network.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits.

Accordingly, claims 43-47 have been withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Applicant indicates, page 11, section (35 U.S.C. § 101 *rejections*), that "Claims 2-28 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. Claims 5-10, 16, 18, 20-21 have been cancelled. The Examiner stated that independent claim 2 lacks a practical application and that the method fails to produce a useful or tangible result. Applicant respectfully disagrees. Independent claim 2 is directed to a method of creating a semantic object representing a target referent. Applicant submits that the subject matter of claim 2 indeed has practical application and that the produced result is both useful and tangible."

The arguments, with respect to the rejections of **claims 2 and all dependent claims** under 35 U.S.C. §101 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn.

However, the newly submitted independent **claims 38 and all dependent claims** have been rejected under 35 U.S.C. §101.

Applicant indicates, pages 12 - 15, section (35 U.S.C. § 103 *rejections*), that ". . . Gupta, Kroenke and over the combination of Gupta and Kreonke." The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the instant application relates to network applications; see specification page 1, lines 1-21.

Accordingly, Gupta discloses the system service and with authority from the client to interact in multiple active knowledge spaces distributed on the Internet, and that provides a collaborative environment for the new generation of internet in personal application; col. 2, lines 35-48.

Kreonke discloses a plurality of semantic object; see col. 3, lines 3, lines 10-13. Further, in col. 4, lines 40-44, create and manipulate data that will be stored in the database.

Therefore, the combination of Gupta in view of Kreonke discloses the claimed limitation.

Furthermore, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must

be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

MPEP 2111: During patent examination, the pending claims must be "given the broadest reasonable interpretation consistent with the specification" Applicant always has the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In *re Prater*, 162 USPQ 541,550-51 (CCPA 1969). The court found that applicant was advocating ... the impermissible importation of subject matter from the specification into the claim. See also *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997) (The court held that the PTO is not required, in the course of prosecution, to interpret claims in applications in the same manner as a court would interpret claims in an infringement suit. Rather, the "PTO applies to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definition or otherwise that may be afforded by the written description contained in application's specification.").

The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. In *re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999).

For the above reasons, it is believed that the last Office Action dated 09 November 2007 was proper. Therefore, the rejection is maintained.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 38--42 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As set forth in MPEP 2106:

As per independent claim 38

The independent claim 38 is directed to a method creating a semantic object of a linking type, in which representing a target referent. Therefore, the mechanism for integrating documents with existing file servers, search engines, semcards embody metadata about their target reference as the purpose of the invention. The claimed subject matter lacks a practical application of a judicial exception (law of nature, abstract idea, naturally occurring article/phenomenon) since it fails to produce a useful and tangible result.

All the dependent claims are rejected under the same rational.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-4, 11-15, 17, 19, 22-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,513,059 issued to Gupta et al., ("Gupta") in view of U.S. Patent No. 5,809,297 issued to Kroenke et al., ("Kroenke").

As per claim 2, Gupta discloses "a computer-implemented method of representing a target referent, the method comprising:

"identifying a receiving an indicator to create a semantic object to represent a target referent" (i.e., context node (entity); see col. 4, line 49);

"identifying a semantic object type for the semantic object suitable to represent the target referent" (i.e., context node (entity); see col. 4, lines 49-51);

"wherein the plurality of meta-tags comprises a predetermined set of meta-tags based on the semantic object type" (see col. 11, lines 30-39); and

"wherein a meta-tag of the plurality of meta-tags is associable with metadata" (i.e., similarities between events and objects (entities); see col. 6, lines 46-51); and

"associating the meta-tag of the plurality of meta-tags with metadata; wherein at least one of, the meta-tag and the metadata is definable by an ontology" (i.e., ontology is specified by rules; see col. 6, lines 41-45).

Gupta fails to explicitly disclose creating the semantic object of the semantic object type to represent the target referent. However, Kroenke discloses creating the semantic object (see Kroeke col. 5, lines 29-30). It would have been obvious to a person ordinary skill in the art at the time the invention

was to modify the method of Gupta by creating the semantic object disclosed by Kroeke (see Kroeke col. 5, line 26-29). Such a modification would allow the method of Gupta to provide a user to create semantic object data models to represent any kind of information that the user desires to store in a database (see Kroeke col. 5, line 26-29), a user to define a formula interpreted in a way that makes semantic sense to the user (see Kroeke col. 22, lines 52-55), thereby, improving the accuracy of the methods and systems for managing and requests in a network.

As per claim 3, Gupta further discloses "assigning one of multiple lifecycle stages to the created semantic object" (see col. 8, lines 43-46)..

As per claim 4, Gupta further discloses "the multiple lifecycle stages include at least: a draft stage, an active stage, an inactive stage and a deleted stage, further comprising subsequently transitioning the created semantic object from one of the multiple lifecycle stages to another" (i.e., lifecycle of task and transaction characteristics; see col. 8, lines 43-48).

As per claim 11, Gupta further discloses "exchanging information about the ontology using the semantic object" (i.e., ontology is specified by rules; see col. 6, lines 41-45).

As per 12 and 13, Gupta substantially discloses the claimed limitation except extracting at least part of the content from the target referent before inclusion in the created semantic object. However, Kroeke discloses created semantic object (see Kroeke col. 5, lines 29-30). It would have been obvious to a person ordinary skill in the art at the time the invention was to modify the method of Gupta by creating a semantic object disclosed by Kroeke (see Kroeke col. 5, line 26-29). Such a modification would allow the method of Gupta to provide a user to create semantic object data models to represent any kind of information that the user desires to store in a database (see Kroeke col. 5, line 26-29), a user to define a formula interpreted in a way that makes semantic sense to the user (see Kroeke col. 22, lines 52-55), thereby, improving the accuracy of the methods and systems for managing and requests in a network.

As per claims 14, 15, 17,19 and 22-28, the limitations of claims 14, 15, 17,19 and 22-28 are similar to claims 2-4 and 11-13, therefore, the limitations of claims 14, 15, 17,19 and 22-28 are rejected on the analysis, and these claims are rejected on that basis.

As per claims 29-37, the limitations of claims 29-37 are similar to claims 2-4 and 11-13, therefore, the limitations of claims 29-37 are rejected on the analysis, and these claims are rejected on that basis.

As per claims 38-42, the limitations of claims 38-42 are similar to claims 2-4 and 11-13, therefore, the limitations of claims 38-42 are rejected on the analysis, and these claims are rejected on that basis.

CONTACT INFORMATION

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JEAN B. FLEURANTIN whose telephone number is 571 – 272-4035. The examiner can normally be reached on 7:05 to 4:35.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JOHN E BREENE can be reached on 571 – 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jean Bolte Fleurantin

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